



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,800	06/30/2000	Chandrasekhar Narayanaswami	13576 (YOR9-2000-0226)	1158

7590 04/14/2004

Richard L Catania  
Scully Scoot Murphy & Presser  
400 Garden City Plaza  
Garden City, NY 11530

EXAMINER
----------

TRAN, HENRY N

ART UNIT	PAPER NUMBER
----------	--------------

2674

13

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/607,800

Applicant(s)

NARAYANASWAMI,  
CHANDRASEKHAR

Examiner

HENRY N TRAN

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-11 and 14-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-11 and 14-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This Office action is in response to the applicant's amendment received 2/2/04 (Paper No. 13). The amendments to the claims were entered. Claims 1, 3, 4, 6-11, and 14-27 remain pending in this application. Applicant's remarks have been fully considered, with the results set forth as following.

#### *Drawings*

1. New corrected drawings are required in this application because of: (i) the defects recited in the prior Office action mailed 3/13/02 (Paper No. 3); and (ii) the proposed drawing correction received 6/17/04 (Paper No. 4), which has been approved by the examiner. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Note: Applicant has not submitted the corrected drawings as requested in the prior Office action mailed 10/31/03 (Paper No. 11).

#### *Specification*

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The use of a confusing variety of terms for the same thing is not

Art Unit: 2674

permitted. The terms are: a smart personal pointing device (see claim 1, and page 2 of the amendment filed 6/17/02, paper no. 4), a personal pointing device (see page 4 of the amendment filed 6/17/02), a smart pointer (see page 7 of the amendment filed 6/17/02), a personalized smart mouse (see page 7 of the amendment filed 6/17/02), a personalized mouse (see page 7 of the amendment filed 6/17/02), a smart mouse (page 14 of the specification), and a mouse device (see claims 16 and 22).

Applicant is required to review the disclosure and make appropriate corrections.

3. As noted in MPEP § 2111, during patent examination, claims are given their broadest reasonable interpretation consistent with the specification. It is proper to use the specification to interpret what the applicant meant by a word or phrase recited in a claim. However, it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Intervet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989).

Words of the claim are generally given their ordinary and customary meaning, unless it appears from the written description that they were used differently by the applicant. Where an applicant chooses to be his or her own lexicographer and defines term with special meanings, he or she must set out the special definition explicitly and with "reasonable clarity, deliberateness, and precision" in the disclosure to give one of ordinary skill in the art notice of the change. See *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP § 2111.01. Pursuant to 35 U.S.C. § 112, 2nd paragraph, "[i]t is applicant's burden to precisely define the invention, and not the [examiner's]." *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). Therefore, it would not be proper for the examiner to give words of the claim special meaning when no such special meaning has been defined by the applicant in the written description. Furthermore, it would not be proper for the examiner to allow a claim and issue the application with an examiner's statement of reasons for allowance setting forth the special definition given to the words of the claim when no such special definition has been defined by the applicant in the written description.

Therefore, applicant is required to explicitly and clearly set forth a special definition provided in the written description for the term in the claims 1, 16 and 22 as recited below:

Art Unit: 2674

**personalized user preferences relating to customized application settings of a user application.**

Note that where the definition set forth in the written description is merely exemplary (where applicant used the phrase "for example"), the examiner will not consider this as a special definition.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 4, 6-9, 14-16, 19-22 and 25-27 stand rejected under **35 U.S.C 103 (a)** as being unpatentable over Mital (U.S. Patent No. 5,878,282) as recited in pages 2 and 3 of the prior Office action mailed 10/31/03 (Paper No. 11).

6. Claims 3, 11, 17, 18, 23 and 24 stand rejected under **35 U.S.C 103 (a)** as being unpatentable over Mital (U.S. Patent No. 5,878,282) in view of Allport (U.S. Patent No. 6,256,019) as recited in pages 3 and 4 of the prior Office action (Paper No. 11).

7. Claim 10 stands rejected under **35 U.S.C 103 (a)** as being unpatentable over Mital (U.S. Patent No. 5,878,282) in view of Banerjee et al (U.S. Patent No. 6,292,181) as recited in page 4 of the prior Office action (Paper No. 11).

*Response to Arguments*

8. Applicant's arguments provided in pages 9-12 filed with the amendment received 02/02/04 (Paper No. 12) have been fully considered but they are not persuasive because of the following reasons.

Regarding independent claims 1, 16 and 22:

(i) applicant argued that “the user preference data according to the invention that is being transferred to the portable device is used to change the application settings of a like application, executing on a first user device and transferred to the second device having the like executing application to which the user customized settings are to be transferred”. Meanwhile, Mital invention is just for transferring data to a second device, which are shown by the applications executing on the second device. Mital invention is not concerned about transferring user preferences relating to customized application settings of a user application; does not teach the transfer of “user preferences” or setting data; and does not teach the ability to port user application preference information maintained on a first computer device to the same application executing on a second computing device so that the application executing on the second device is formatted in accordance with the users settings, see pages 9-10 of the amendment. The examiner respectfully disagrees because the Mital invention teaches clearly a portable information device (PID) 30 capable of interfacing with a computer 12; wherein, the PID device 30 comprising a mechanism (CPU) 60 and a memory device comprising RAM 62 and ROM 64 for storing applications and user customized application settings or user preferences data relating to user application data for being transferred or downloaded from and/ or to the computer 12. user data,

Art Unit: 2674

personal data, or user application data, which is read on user preferences data or customized application settings, are transferred, downloaded or uploaded, between the computer 12 and the PID 30, see col. 4, line 26 to col. 5, line 28. Accordingly, Mital teaches the transferring of user preference data in the form of customized user application personal data between two computing devices. Obviously, a second computing device having a like application instead of the computer 12, which is read on the first computing device, can be utilized for the transferring of user data as recited in the prior Office action. The motivation for doing so is provided in said action.

(ii) applicant further argued that the smart mouse device in the present invention requires the second computer device to first determine the application on which the smart mouse is present and then adjust the settings as defined in figures 4(a)-(b); further, there is no concept of the application itself executing on the smart mouse device itself to which reference information is associated. Meanwhile, Mital invention is a correspondence between application on the PC to the application on its PID, see pages 11-12 of the amendment. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ... requires the second computer device to first determine the application on which the smart mouse is present and then adjust the settings as defined in figures 4(a)-(b)) are not recited in the rejected claims; further, figures 4(a)-(b) defined processing steps which are orderly performed for producing the intended results; while no such orderly processing steps recited in the claimed invention; and further also, the terms, e.g.

Art Unit: 2674

personalized profile (step 507), current files and a temporary directory (step 510) are not defined in the specification and/ or claims.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(iii) applicant argued that the Allport reference does not teach the transfer of user preferences relating to customized application settings of a user application for storage in the smart pointing device that are subsequently registered with a common application on a visited (second computing) device, see page 12 of the amendment. Again, the above features upon which applicant relies are not recited in the rejected claims. Also, the Allport reference is used to provide the teachings of password protection feature, retaining and restoring of the original user application preferences as recited in the prior Office action.

Therefore, the rejections to the claims stand as were rejected in the previous Office action.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after



Art Unit: 2674

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N. TRAN whose telephone number is 703-308-8410. The examiner can normally be reached on Mon – Fri from 8:00AM – 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD A. HJERPE, can be reached at 703-305-4709.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

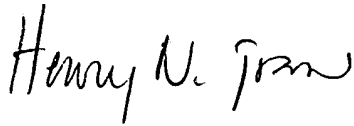
**or fax to:**

703-872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Art Unit: 2674

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is 703-306-0377.

A handwritten signature in black ink that reads "Henry N. Tran". The signature is written in a cursive, flowing style.

HENRY N. TRAN  
Examiner  
Art Unit 2674

Hnt  
April 13, 2004